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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,904	02/13/2004	Jun Hirai	248884US6	6087

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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DEGA, MURALI K

ART UNIT	PAPER NUMBER
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3621

NOTIFICATION DATE	DELIVERY MODE
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03/24/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/777,904	<b>Applicant(s)</b> HIRAI ET AL.	
	<b>Examiner</b> MURALI K. DEGA	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) None is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>20091001</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Acknowledgements***

1. This Office action responds to the Amendments and Remarks filed by the Applicants on 18 November 2009.
2. Claims 1-12 are pending.
3. Claims 1-12 have been examined.

### ***Claim Rejections - 35 USC § 112 – 2<sup>nd</sup> Paragraph***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 5 recites “the title” in line 17 of page 4. The claim is indefinite because there is insufficient antecedent basis for this limitation in the claim. It is not clear to one of ordinary skill in the art if the Applicant is referring to “a characteristic of the printing surface” or “information of the signals” or “the signals recorded” as recited in claim 3 for medium identifying information or some other “title”.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Akiyama et al. (US 5,805,699) in view of Hiratsuka. (US 2004/0064380).

8. With respect to claims 1, 6, 7, 9-12:

9. Akiyama discloses a contents copying management system ("a software copying system", C 3, ll. 41-42) configured by connecting a contents copying apparatus ("End user's site", C 5, ll. 40-41, also Fig. 4) and a copying management device ("Central Site", C 5, ll.41-42, Fig. 4 and also Fig. 1, **item 5**) by network ("communication line or a delivery channel", C 5, ll. 46-47), said contents copying apparatus comprising:

- a. a controller configured to acquire medium identifying ("software identifier SIDI", Fig. 2 step S1) information specific to and characterizing a recorded-contents-carrying an original recording medium.
- b. the controller further configured to acquire apparatus identifying information ("Storage medium identifier IDk", Fig. 2, step S1) specific to and indicating said contents copying apparatus itself.
- c. a first transmission/reception section that transmits said medium identifying information ("software identifier SIDI", Fig. 2 step S1) and said apparatus identifying information ("Storage medium identifier IDk", Fig. 2, step S1) to said copying management device ("Central Site", C 5, ll.41-42, Fig. 4 and also Fig. 1, **item 5**) as copying-related combination information.
- d. the first transmission/reception section further receives copying authorizing information ("Signature", C 4, line 19) generated by said copying

management device on the basis of said copying-related combination information at the time of accessing said copying management device, after transmitting said medium identifying information (“At the central site 5, the signature generating means 6 receives the contents identifier and storage medium identifier and sends back to the user a signature that is generated from the received identifiers. This signature authorizes the user as a licensee having the right to copy the software product”, C 4, ll. 15-20).

e. Akiyama discloses a software copying system comprising End user’s site as Data processing terminal station, which consists of ‘content and medium identifier reading means’, where End user’s site is in communication with Central site. It is inherent that the ‘content and medium identifier reading means’ acts as a ‘Controller’ as recited in the present claim.

f. Akiyama discloses a signature generated authorizing the user to copy contents (C 4, ll. 15-20) but does not explicitly disclose the signature controlling the copying operation.

g. However, Hiratsuka teaches the controller further configured to control an operation of copying said contents in response to said copying authorizing information (“copy control data”, ¶ [0007]).

h. Therefore

i. copying management device comprising:

j. a database (“User profile database”, Figs. 1 and 4, item 13) that registers and stores said copying-related combination information received from said

contents copying apparatus in advance (“the user is registered in a user profile database at the central site 5”, C 4, ll. 21-22).

k. a control section (“Comparing unit” Abstract), configured to compare said copying-related combination information received at the time of access by said contents copying apparatus with said copying-related combination information registered in said database in advance (“The signature generating/comparing means then compares the first signature stored in the target storage medium with the second signature”, C 2, ll. 26-28), that judges agreement or disagreement of said combinations of medium identifying information and apparatus identifying information, and that generates copying authorizing information for authorizing an operation of copying the contents in response to agreement of said combinations but generating that generates copying non-authorizing information for not authorizing any operation of copying the contents in response to disagreement of said combinations (“Data copying means retrieves the software product out of the master storage medium and writes the software product into the target storage medium, when the first and second identifiers turned out to be identical as a result of the comparison performed by the signature generating/comparing means”, C 2 ll. 29-34).

l. a second transmission/reception section (“communication line or a delivery channel”, C 5, ll. 46-47) that transmits said copying authorizing information to said contents copying apparatus (“At the central site, a signature

generating unit produces a first signature from those identifiers and sends it back to the user's site", Abstract)

10. With respect to claim 2:

11. Akiyama discloses a signature generated authorizing the user to copy contents (C 4, ll. 15-20) but does not explicitly disclose the signature controlling the copying operation.

12. However, Hiratsuka teaches the controller further configured to control an operation of copying said contents in response to said copying authorizing information ("copy control data", ¶ [0007]).

13. Therefore

14. With respect to claim 3:

15. Akiyama discloses wherein said medium identifying information ("software identifier SIDI", Fig. 2 step S1) is a characteristic of the printing surface of said recorded-contents-carrying original recording medium produced at the time of printing, information of the signals on the recording surface of said recorded- contents-carrying original recording medium, the signals recorded on the recording surface, or a combination of one or more of: the characteristic of the printing surface of said recorded-contents-carrying original recording medium produced at the time of printing, information of the signals on the recording surface of said recorded-contents- carrying original recording medium, or the signals recorded on the recording surface ("contents identifier uniquely assigned to a subject data file", C 2 ll. 40-41).

16. With respect to claim 4:

17. Akiyama discloses a signature generated authorizing the user to copy contents (C 4, ll. 15-20) but does not explicitly disclose the signature controlling the copying operation.

18. However, Hiratsuka teaches the controller further configured to control an operation of copying said contents in response to said copying authorizing information ("copy control data", ¶ [0007]). Further, Hiratsuka teaches display a predetermined warning image on a display when copying is not authorized according to said copying authorizing information ("message", ¶ [0057])

19. Therefore

20. With respect to claim 5:

21. Akiyama discloses wherein said database registers said medium identifying information ("software identifier SIDI", Fig. 2 step S1) according to the title of said contents on a title by title basis when registering and storing in advance said copying-related combination information received from said contents copying apparatus, and said control section is further configured to select said medium identifying information to be compared according to said title when it compares said copying-related combination information received at the time of said access of said contents copying apparatus with said copying-related combination information registered in advance in said database.

22. But Akiyama does not explicitly disclose title of said contents.

23. However, Hiratsuka teaches use of content titles for executing a request for copying of the corresponding content (¶ [0055]).



24. With respect to claim 8:

25. Akiyama discloses wherein said controller is further configured to encode the contents, using said apparatus identifying information as key, when carrying out an operation of copying said contents ("the encrypted certification key arrived at the end user's site from the central site is written into the target storage medium", C 2, ll. 52-55)

### ***Claim Interpretation***

26. The USPTO interprets claim limitations that contain statements such as "*if, may, might, can, could, when, potentially, possibly*", as optional language (this list of examples is not intended to be exhaustive). As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted (In re Johnston, 77 USPQ2d 1788 (Fed. Circ. 2006)). They will be given less patentable weight, because language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

27. Because claims recite neither "step for" nor "means for," claims fail Prong (A) as set forth in MPEP §2181. Because claims fail Prong (A) as set forth in MPEP §2181, the Examiner concludes that claims do not invoke 35 U.S.C. §112, 6th Paragraph. See also *Ex parte Miyazaki*, 89 USPQ2d 1207, 1215-16 (B.P.A.I. 2008)(precedential).

***Response to Arguments***

28. Claim rejections based on 35 USC § 101 and 35 USC § 112 – 2<sup>nd</sup> Paragraph in the office action mailed on 21 August 2009 are withdrawn in view of the amendments made to claims and clarifications provided in the Remarks filed on 18 November 2009.

29. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

30. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MURALI K. DEGA whose telephone number is

(571)270-5394. The examiner can normally be reached on Monday to Thursday 7.30 to 4.00 ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on (571)272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Murali K. Dega/  
Art Unit 3621  
January 30, 2010

/Calvin L Hewitt II/  
Supervisory Patent Examiner, Art Unit 3685